

Application Serial No.: 09/785,433
Amendment dated February 20, 2004
Reply to Office Action dated November 20, 2003

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-78 are presently active in this case, Claims 1, 11, 39, 49, 58, and 72 having been amended by way of the present Amendment.

In the outstanding Official Action, the disclosure was objected to for containing an embedded hyperlink and/or other form of browser-executable code on page 17, line 14. The specification has been amended to delete the language objected to in the Official Action. Accordingly, the Applicants request the withdrawal of the objection to the disclosure.

The status of the application mentioned on page 2 has not changed at this time.

The drawings were objected to as being informal. Submitted concurrently herewith are Replacement Sheets which include formal Figures 4-10. Accordingly, the Applicants request the withdrawal of the objection to the drawings.

Claims 1-4, 6-12, 15-18, 20-23, 25-31, 34-37, 39-42, 44-50, 53-56, 58-63, 65-70, and 72-77 were rejected under 35 U.S.C. 102(e) as being anticipated by Zhao et al. (U.S. Patent No. 6,141,753). Claims 5, 24, 43, 64, 71, and 78 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. in view of Houser et al. (U.S. Patent No. 5,606,609). Claims 13, 14, 32, 33, 51, and 52 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. in view items upon which Official Notice has been taken. Claims 19, 38, and 57 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zhao et al. in view of Stefik et al. (U.S. Patent No. 6,233,684). For the reasons discussed below, the Applicants request the withdrawal of the art rejections.

Application Serial No.: 09/785,433
Amendment dated February 20, 2004
Reply to Office Action dated November 20, 2003

In the Office Action, the Zhao et al. reference is indicated as anticipating each of Claims 1, 20, 39, 58, 65, and 72. However, the Applicants note that a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As will be demonstrated below, the Zhao et al. reference clearly does not meet each and every limitation of the pending independent claims.

Claims 1 and 58 of the present application recite methods of managing documents comprising the steps of receiving, at a centralized document manager (see, e.g., Figure 2 of the present application for a non-limiting embodiment), a request from a remote user, and selecting, using the document manager, an application service provider based on the request. Claims 39 and 72 recite computer program products comprising a first computer code device configured to receive a request, at a centralized document manager, from a remote user, and a second computer code device configured to select, using the document manager, an application service provider based on the request. The Applicants submit that the Zhao et al. reference does not disclose the above features.

The Official Action indicates that the Zhao et al. reference describes a copy client that corresponds to the remote user of the pending claims, and a copy server 103(j) that corresponds to the application service provider. The Official Action also indicates, with respect to original Claims 11, 30, and 49, that the Zhao et al. reference describes a transaction manager 115 on the copy server that corresponds to the document manager of the pending claims. The Applicants note, however, that the transaction manager 115 in the Zhao et al.

Application Serial No.: 09/785,433
Amendment dated February 20, 2004
Reply to Office Action dated November 20, 2003

reference is not centralized, but rather is provided in each individual copy server. The transaction manager 115 of the Zhao et al. reference does not select a copy server based upon a request from a copy client, since the transaction manager 115 is in fact part of the copy server 103(j) and thus a selection step is never performed.

Accordingly, the Applicants submit that the Zhao et al. reference does not disclose all of the limitations expressly recited in Claims 1, 39, 58, and 72, and thus the Applicants respectfully request the withdrawal of the anticipation rejections thereof.

Claims 2-19 are considered allowable for the reasons advanced for Claim 1 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 1.

Claims 40-57 are considered allowable for the reasons advanced for Claim 39 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 39.

Claims 59-64 are considered allowable for the reasons advanced for Claim 58 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 58.

Claims 73-78 are considered allowable for the reasons advanced for Claim 72 from which they depend. These claims are further considered allowable as they recite other

Application Serial No.: 09/785,433
Amendment dated February 20, 2004
Reply to Office Action dated November 20, 2003

features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 72.

Claims 20 and 65 of the present application recite systems for managing documents comprising means for receiving a request from a remote user, and means for selecting an application service provider based on the request. The specification describes an embodiment including a centralized document manager that includes the means for receiving and the means for selecting. The Applicants submit that such means plus function terminology in accordance with 35 U.S.C. 112, sixth paragraph, should be interpreted in light of the structure disclosed in the specification and equivalents thereof, as per the Federal Circuit's decision in the *In re Donaldson* decision as discussed in MPEP 2181-2183. The Applicants note that not only is the structure of the present invention distinct from that described in the Zhao et al. reference, but also the function of the present invention, as is described above with respect to Claims 1, 39, 58, and 72. Accordingly, the Applicants respectfully request the withdrawal of the anticipation rejections of Claims 20 and 65.

Claims 21-38 are considered allowable for the reasons advanced for Claim 20 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 20.

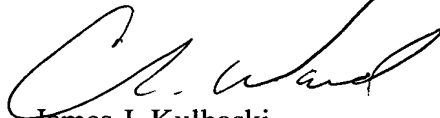
Claims 66-71 are considered allowable for the reasons advanced for Claim 65 from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed, taught, nor suggested by the applied references when those features are considered within the context of Claim 65.

Application Serial No.: 09/785,433
Amendment dated February 20, 2004
Reply to Office Action dated November 20, 2003

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Registration No. 34,648
Attorney of Record

Christopher D. Ward
Registration No. 41,367

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

JJK:CDW:brf

I:\atty\cdw\200520US28X\am1.doc